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| 10/740,030 | 12/18/2003 | Michael J. Rojas | 17188 | 1731 |

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| EXAMINER | |
|---|---|
| SMITH, CREIGHTON H | |

| ART UNIT | PAPER NUMBER |
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| 2614 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/740,030 | ROJAS, MICHAEL J. | |
| | Examiner | Art Unit | |
| | Creighton H. Smith | 2614 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 JUL '08*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5, 11-18, 26-29, 43, 45, 51-54, 65, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal, Jr. '226 in view of Bernstein et al, U.S. Pat. App. Pub. #2004/00128356.

McZeal discloses in col. 4, lines 18 et seq. that until his invention there was no device which could take full advantage of the Internet and IM for voice quality purposes, and which uses computer data networks for voice. In col. 28, lines 5 et seq. McZeal discloses that his invention provides customers with instant IM which uses VoIP. In col. 16, lines 39 et seq. McZeal discloses that his invention can use both the Internet and the PSTN. Bernstein et al disclose in P.0050 that each IM session has a universally unique identifier, which the server computer uses to identify and store individual Instant Messages. To have provided Bernstein et al teaching of storing IM in a server in McZeal's communication system would have been obvious to a person having ordinary skill in the art, because the skilled practitioner in this communication art will realize the need to store messages if the called party lacked the present ability to receive the IM.

For claims 2 & 3, McZeal discloses in cols. 1 & 16, lines 42-43 & 25-30 that his invention can be used in local or wide area networks - LAN/WAN.

Regarding claim 11, see McZeal @ col. 16, lines 42 & 59-60. Pertaining to claim 20, with McZeal's disclosure that his device that his device can be used in either a WAN

(Internet) or LAN (local area network). If the voice message is to be routed out beyond a LAN, then an external serving system will have to be employed until the message reaches the recipient inside of the LAN, whereupon the LAN and its associated server will route the message to the intended recipient.

Claims 4, 19, 20, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al as applied to claim 1 above, and further in view of Williams et al.

Williams et al disclose in P.0055 that a messaging server (105) will save a voice message and send a list of recipients to the user from an address book. To have provided Williams teaching of a server providing a user a calling list of recipients in McZeal's Instant Voice Messaging server system would have been obvious to a person having ordinary skill in the art because the skilled practitioner in the communications and server arts will readily realize that there are an unlimited amount of commands and information that a server can hold which can be communicated to anyone throughout the world that has proper equipment.

Claims 7, 22, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al as applied to claim 1 above, and further in view of Sagi et al.

Sagi et al disclose in claim 24 where a server will receive an audio file from a subscriber, and then in claim 29 Sagi et al disclose that the transmission is sent to a 2nd subscriber. To have similarly used Sagi et al disclosure of transmitting an audio file to a server in McZeal"s device would have been obvious to a person having ordinary skill in

the art, because the skilled practitioner in communications art will realize that the sending party can either directly record a voice message or send an audio file. Either way, a called party will receive the voice message.

Claims 8, 23, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al as applied to claim 1 above, and further in view of Goodman et al.

Goodman et al disclose in P.0033 that an audio message can be transformed from any of encrypted, decrypted, compressed, or decompressed format. To have similarly provided Goodman's teaching of encrypting, decrypting, compressing, and decompressing audio into McZeal's device would have been obvious to a person having ordinary sill in the art, because by compressing the audio will take up less memory in the server.

Claims 9, 24, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al as applied to claim 1 above, and further in view of Gierachf.

Gierachf discloses in P.0044 in Step- 266 that the audio data or voice message is sent to audio buffer 19B'. To have similarly used Gierachf's method of buffering the audio data in McZeal's apparatus would have been obvious to a person having ordinary skill in the art.

Claims 10, 25, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al as applied to claim 1 above, and further in view of Creamer et al, U.S. Pat. App. Pub. #2003/0126207.

Creamer et al disclose in P.0006 that IM chat systems can also support the exchange of attachments. Attachments are electronic files such as images, documents, or binary objects which can be attached to an IM and transmitted therewith. To have used creamer et al teaching of attaching an electronic file to an IM in McZeal's instant voice messaging system would have been obvious to a person having ordinary skill in this art because the skilled practitioner will realize the efficiency of alerting a multitude of persons located throughout the world that an email/document from the sender is being sent to the recipients, such as the minutes of an important meeting.

Claims 30-33, 35, 41, 55, 57, 63, 64, 67, 69, 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al as applied to claim1 above, and further in view of Monroe.

Monroe discloses in col. 20, lines 28 et seq. and in Fig. 9 a local server (460) connected to a LAN, which provides a gateway to a WAN like the Internet. In col. 32, lines 11 et seq. Monroe discloses that pre-recorded voice messages can be delivered to a modem and then delivered throughout the network. To have used Monroe's teaching of connecting a local server to an Internet server in McZeal's device would have been obvious to a person having ordinary skill in the art because a local server will only reach a few, select individuals in close proximity to each other, whereas the Internet will have global reach, thus insuring connectivity to clients worldwide.

Claims 42 & 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al and Monroe as applied to claim 30 above, and further in view of Boukobza, U.S. Pat. App. Pub. #2006/0167883.

Boukobza's method as disclosed in P.0020 is for load balancing databases within a network having a plurality of servers. To have provided Boukobza's method of load balancing servers in Monroe as applied to McZeal would have been obvious to a person having ordinary skill in the art, because the skilled practitioner would realize that as one server becomes filled with IM, or as one server is being inundated with high volume traffic, it would become necessary to route some of those IM to another server for storing.

Claims 34, 56, 68 are4 rejected under 35 U.S.C. 103(a) as being unpatentable over Mczeal in view of Bernstein et al and Monroeas applied to claim 30 above, and further in view of Williams et al.

Claims 37, 59, 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al and Monroe as applied to claim 30 above, and further in view of Sagi et al.

Claims 38, 60, 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al and Monroe as applied to claim 30 above, and further in view of Goodman et al.

Claims 39, 61, 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al and Monroe as applied to claim 30 above, and further in view of Gierachf.

Claims 40, 62, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over McZeal in view of Bernstein et al and Monroe as applied to claim 30 above, and further in view of Creamer et al.

Any inquiry concerning this communication should be directed to Creighton H. Smith at telephone number 571/272-7546.

04 AUG '08

/Creighton H Smith/
Primary Examiner, Art Unit 2614